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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,322	03/09/2000	Scott Faber	004704.P002	2806

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Erica W Kuo  
Blakely Sokoloff Taylor & Zafman LLP  
12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, CA 90025-1026

EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/522,322	FABER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Susanna M. Diaz	3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 July 2003.
- 2a) This action is **FINAL**.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-56 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>18</u> . | 6) <input type="checkbox"/> Other: _____                                     |

### **DETAILED ACTION**

1. This Non-Final Office action is responsive to Applicant's after-final response filed July 7, 2003.

No amendments have been made to the claims.

Claims 1-56 are pending.

2. The previously pending objection to the specification is withdrawn in response to Applicant's submission of a corrected substitute specification.

#### ***Response to Arguments***

3. Applicant's arguments filed July 7, 2003 properly invoke the 35 U.S.C. § 103(c) exception; therefore, the previously pending art rejection is withdrawn. Additionally, finality of the previous Office action is withdrawn. New rejections are presented below.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Expertcity.com's Internet service, as disclosed in "Expertcity.com Launches Premier Online Marketplace for Expert Services" (which states that the Expertcity.com web site

was launched on August 30, 1999) and "Rent-An-Expert on the Web," in view of answers.com, as disclosed in "Applying Technology News."

Expertcity.com discloses a system for delivering information, the system comprising:

[Claim 1] a communications interface ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11); and a controller computer being linked with the communications interface ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11), the controller computer having:

a server to display information provided by an information provider ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11);

a first logic unit linked with the server to establish via the communications interface a first communication connection with the information provider over which the information provider communicates the information ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11); and

a second logic unit linked with the server to establish, in response to a user selecting to receive the information and via the communications interface, a second communications connection with the user and to deliver the information via the second communications connection to the user ("Rent-An-Expert on the

Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11);

[Claim 2] wherein the server further stores a description of the expertise of each information provider ("Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶¶ 1, 4);

[Claim 3] wherein the controller computer further has a third logic unit linked with the server to establish a computer connection with an information provider computer and to receive via the computer connection the description from the information provider ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶¶ 1, 4);

[Claim 4] wherein the computer connection is established through a web site accessible by the information provider computer ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 5] wherein the controller computer further has a third logic unit linked with the server to establish a computer connection with a user computer and to deliver the description to the user computer via the computer connection ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶¶ 1, 4);

[Claim 6] wherein the computer connection is established through a web site accessible by the user computer ("Rent-An-Expert on the Web": ¶¶ 3, 4);

[Claim 7] wherein the description includes a price for the information ("Rent-An-Expert on the Web": ¶¶ 3, 4, 6);

[Claim 8] wherein the price includes a rate per period of time ("Rent-An-Expert on the Web": ¶¶ 4, 6);

[Claim 10] wherein the first communications connection includes a video connection ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11);

[Claim 11] wherein the first communications connection is established over a computer network ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11);

[Claim 14] wherein the second communications connection includes a video connection ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11);

[Claim 15] wherein the second communications connection is established over a computer network ("Rent-An-Expert on the Web": ¶¶ 3, 4; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11);

[Claim 17] wherein the controller computer has a third logic unit to bill the user for the information ("Rent-An-Expert on the Web": ¶ 6);

[Claim 18] wherein the controller computer has a fourth logic unit to track how long the information is delivered to the user and the third logic unit bills the user based upon how long the information is delivered ("Rent-An-Expert on the Web": ¶ 6);

[Claim 19] wherein the database further stores information about a user account ("Rent-An-Expert on the Web": ¶ 6 -- A credit card transaction utilizes a type of user

account from which an amount is deducted, i.e., a transaction is charged against the user's available credit);

[Claim 20] wherein the controller computer has a third logic unit to deduct an amount from the user account for the information ("Rent-An-Expert on the Web": ¶ 6 -- A credit card transaction utilizes a type of user account from which an amount is deducted, i.e., a transaction is charged against the user's available credit);

[Claim 21] wherein the controller computer has a third logic unit to track how long the information is delivered to the user and a fourth logic unit to deduct from the user account an amount based upon how long the information is delivered ("Rent-An-Expert on the Web": ¶ 6 -- A credit card transaction utilizes a type of user account from which an amount is deducted, i.e., a transaction is charged against the user's available credit);

[Claim 23] wherein the controller computer has a third logic unit to credit an amount to the account when the information is delivered to the user ("Rent-An-Expert on the Web": ¶ 6 -- Expertcity.com connects the customers and the experts and keeps "an undisclosed percentage of the fee," thereby implying that the experts are credited based on how long they assisted customers);

[Claim 24] wherein the controller computer has a third logic unit to track how long the information is delivered to the user and a fourth logic unit to credit to the account an amount based upon how long the information is delivered ("Rent-An-Expert on the Web": ¶ 6 -- Expertcity.com connects the customers and the experts and keeps "an undisclosed percentage of the fee," thereby implying that the experts are credited based on how long they assisted customers);

[Claim 25] wherein the controller computer has a third logic unit to track how long the information is delivered to the user and a fourth logic unit to credit to the account an amount based upon how long the information is delivered minus a fee ("Rent-An-Expert on the Web": ¶ 6 -- Expertcity.com connects the customers and the experts and keeps "an undisclosed percentage of the fee," thereby implying that the experts are credited based on how long they assisted customers).

As per claims 1-25, Expertcity.com's server facilitates a connection between customers and experts who can provide them with desired information (e.g., knowledge from the live experts); however, Expertcity.com's information is "live" knowledge as opposed to the claimed information recorded and stored in a database. Answers.com makes up for this deficiency in its teaching of an information broker that "uses a combination of published information, proprietary databases, and electronic data from qualified people who provide their own personal knowledge" ("Applying Technology News": ¶ 3) to provide paying customers with answers to their submitted inquiries ("Applying Technology News": ¶ 2). Answers.com meets the similar information needs met by Expertcity.com, albeit in a more delayed fashion that enables more research to be conducted when needed to answer a difficult question. Expertcity.com lays the framework for quickly and automatically supplying similarly requested information in a computer network; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize Expertcity.com's framework to supply customers with desired information from a

database (as opposed to a live expert source) in order to attract a wider base of customers, such as those who need complex information that requires more research to be conducted in order to glean a more thorough and accurate response.

Regarding claims 9, 12, 13, and 16, Expertcity.com fails to expressly teach that the customers may connect audibly with an expert, such as through the use of telephone connections. However, Official Notice is taken that it is old and well-known in the art of communications to enhance Internet communications with voice capabilities so that two users connected via the Internet can converse with one another. Furthermore, many Internet users connect to the Internet through a modem that dials up to the Internet though a telephone line. These voice capabilities via the Internet (and ultimately through a telephone line) reap the benefits of facilitating oral communications, which in and of themselves are more efficient timewise for conveying ideas than written communications, at cheaper rates (as compared to making a long-distance call directly through the telephone). Expertcity.com performs the generic functionality (e.g., connecting the customers to experts) of claims 9, 12, 13, and 16 (see "Rent-An-Expert on the Web": ¶¶ 3, 4, 6; "Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 11). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enhance Expertcity.com's generic functionality (e.g., connecting the customers to experts) corresponding to claims 9, 12, 13, and 16 with voice capabilities so that two users connected via the Internet can converse with one another through telephone lines in order to reap the benefits of facilitating oral communications, which in and of

themselves are more efficient timewise for conveying ideas than written communications, at cheaper rates (as compared to making a long-distance call directly through the telephone).

As per claim 22, Expertcity.com pays out a percentage of income to the service providers ("Rent-An-Expert on the Web": ¶ 6); however, it fails to explicitly teach that the database further stores information about an account set up for the information provider. Official Notice is taken that it is old and well-known in the art to set up electronic payroll accounts for employees. Such accounts facilitate quick salary payments from an employer to their employees. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to provide Expertcity.com's experts with electronic payroll accounts through Expertcity.com's expert system in order to facilitate quick salary payments from Expertcity.com to its employed experts.

[Claims 26-40]      Claims 26-40 recite limitations already addressed by the rejection of claims 1-25 above; therefore, the same rejection applies.

Furthermore, as per claims 30-32, Expertcity.com teaches that a customer can "obtain real-time, personalized expertise on a wide range of subjects from solving computer problems to assistance with personal finance. Customers can select from a roster..." ("Expertcity.com Launches Premier Online Marketplace for Expert Services": ¶ 1). In other words, Expertcity.com teaches that the expert descriptions are included in a list of information providers, as per claim 30. However, Expertcity.com does not

expressly teach that the list of information providers is delivered to the user in response to a keyword search (claim 31) or a category selection (claim 32). Official Notice is taken that it is old and well-known in the art of data selection to narrow down desired search results by either utilizing a keyword search or a category selection. Both practices facilitate speedier retrieval of specifically desired information, especially when one must search through a large amount of data. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enhance Expertcity.com with the ability to perform keyword searches (claim 31) and category selection (claim 32) to identify experts from a collection of experts in order to facilitate speedier retrieval of specifically desired information (such as available experts specializing in a given field), especially when one must search through a large amount of data.

[Claims 41-56]      Claims 41-56 recite limitations already addressed by the rejection of claims 1-40 above; therefore, the same rejection applies.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6,223,165 in view of answers.com, as disclosed in "Applying Technology News." The rejection under 35 U.S.C. § 103(a) found in Paper No. 17 sets forth the differences between the claimed invention in U.S. Patent No. 6,223,165 and the instantly claimed invention and why such differences are deemed to be obvious variants over one another.

8. Claims 1-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 6,523,010 in view of answers.com, as disclosed in "Applying Technology News." The rejection under 35 U.S.C. § 103(a) found in Paper No. 17 sets forth the differences between the claimed invention in U.S. Patent No. 6,223,165 (whose claims recite limitations similar to those recited in claims 1-47 of U.S. Patent No. 6,523,010) and the instantly claimed invention and why such differences are deemed to be obvious variants over one another.

9. Claims 1-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,546,372 in view of answers.com, as disclosed in "Applying Technology News." The

rejection under 35 U.S.C. § 103(a) found in Paper No. 17 sets forth the differences between the claimed invention in U.S. Patent No. 6,223,165 (whose claims recite limitations similar to those recited in claims 1-37 of U.S. Patent No. 6,546,372) and the instantly claimed invention and why such differences are deemed to be obvious variants over one another.

10. Claims 1-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of U.S. Patent No. 6,549,889 in view of answers.com, as disclosed in "Applying Technology News." The rejection under 35 U.S.C. § 103(a) found in Paper No. 17 sets forth the differences between the claimed invention in U.S. Patent No. 6,223,165 (whose claims recite limitations similar to those recited in claims 1-41 of U.S. Patent No. 6,549,889) and the instantly claimed invention and why such differences are deemed to be obvious variants over one another.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450**

or faxed to:

**(703)305-7687** [Official communications; including After Final communications labeled "Box AF"]

**(703)746-7048** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7<sup>th</sup> floor receptionist.

*Susanna Diaz*  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623  
August 12, 2003